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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,183	10/22/2003	Andrew J. Pajakowski	740270-2919	3944

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EXAMINER

GIBSON, ERIC M

ART UNIT PAPER NUMBER

3661

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/690,183

Applicant(s)

PAJAKOWSKI ET AL.

Examiner

Eric M. Gibson

Art Unit

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/19/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed 10/22/2003 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. No copy of a PTO-1449 or similar listing any references was found with the received correspondence.

The information disclosure statement filed 10/19/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Specifically, no copies of the non-patent literature references have been included with the application. Furthermore, the "webpages" references do not include any dates of publication. The references have therefore been crossed of the IDS as not considered (see attached copy).

***Priority***

This application discloses and claims only subject matter disclosed in prior Application No. 09/583,892, filed 5/31/2000, and names an inventor or inventors named in the prior application. Accordingly, this application may constitute a continuation or division. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 72 is rejected under 35 U.S.C. 102(b) as being anticipated by Schwanz et al. (US006189057B1).

Per claim 72, Schwanz teaches a handheld computer with a memory and an external data port (see figure 1 and column 1, lines 32-51) and an adapter (10, figure 1) for creating a pathway (22, figure 1) between the bus connector and the external data port including a data port connector for connection with the external data port of the computer (16, 20, figure 1), a bus compatible connector for connection with the bus connector (14, figure 1), and an adapter microprocessor (12, figure 1) for protocol conversion (column 3, lines 15-25).

Claim 72 is rejected under 35 U.S.C. 102(b) as being anticipated by Fieramosca et al. (US005935180A).

Per claim 72, Fieramosca teaches a handheld computer (12, figure 1) with a memory (92, figure 2) and an external data port (30, figure 1) and an adapter (14, figure 1) for creating a pathway between the bus connector and the external data port including a data port connector for connection with the external data port of the computer (36, figure 1), a bus compatible connector for connection with the bus connector (44, figure 1), and an adapter microprocessor for protocol conversion (column 7, lines 10-31).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 3661

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 72 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schwanz or Fieramosca in view of Liebl et al. (US006236917B1).

Per claim 72, Schwanz and Fieramosca teach the invention as explained in the rejections of claim 72 above. Furthermore, the Examiner considers the “wherein” clause beginning at line 23 of the claim 72, to be merely a recited intended use. The systems of Schwanz and Fieramosca would necessarily need to convert the signal levels for the invention to work as disclosed. However, as evidence of signal conversion being a necessary and known process to one of ordinary skill in the art at the time of the invention, the Examiner cites the teaching of Liebl. Liebl teaches that signal level conversion is necessary for a system, such as that of Schwanz or Fieramosca, that translates data from a vehicle bus to a computer, and furthermore, that such signal level conversion would have been well known to one of ordinary skill in the art at the time of the invention (see Liebl, column 3, line 57 – column 4, line 27).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chen (US 20030060953A1) teaches a method and system for computer network implemented vehicle diagnostics. McClure et al. (US006772248B1) teaches a protocol adapter for in-vehicle networks. Godau et al. (US006407554B1) teaches a diagnostic tester for electronic control devices in a variety of motor vehicle

Art Unit: 3661

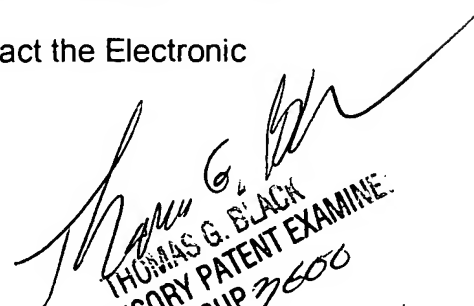
types. Shultz (US006321151B1) teaches an automotive diagnostic interface device. Berra et al. (US005555498A) teaches a circuit and method for interfacing vehicle controller and diagnostic test instrument. Gurne et al. (US005541840A) teaches a hand held automotive diagnostic service tool. Alfaro et al. (US005491418A) teaches an automotive diagnostic communications interface. Berra (US005459660A) teaches a circuit and method for interfacing with a vehicle computer. Krass, Jr. et al. (US004853850A) teaches a vehicle computer diagnostic interface apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric M. Gibson whose telephone number is (571) 272-6960. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on (571) 272-6956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EMG

  
THOMAS G. BLACK  
SUPERVISORY PATENT EXAMINER  
GROUP 3600